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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Applicati n Number	10/014,716	
	Filing Date	December 14, 2001	
	First Named Inv nt r	Fodor	
	Group Art Unit	1627	
	Examiner Name	Ponnaluri, P.	
Total Number of Pages in This Submission	1	Attorney Docket Number	018547-048200US

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ENCLOSURES (check all that apply)		
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Remarks		The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430. Total number of pages <u>does not</u> include cited references.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm and Individual name	Townsend and Townsend and Crew LLP William Schmonsees Reg No. 31,796
Signature	
Date	October 18 2002

CERTIFICATE OF MAILING			
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on this date: October 25, 2002			
Typed or printed name	Chris Fitting		
Signature		Date	October 25, 2002

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PA 3258562 v1



PATENT
Attorney Docket No.: 018547-048200US
Client Reference No.: 1000.3A-Con

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re application of:

Stephen P. A. Fodor et al.

Application No.: 10/014,716

Filed: December 14, 2001

For: VERY LARGE SCALE
IMMOBILIZED POLYMER
SYNTHESIS

Examiner: Ponnaluri, P.

Art Unit: 1627

INFORMATION DISCLOSURE
STATEMENT UNDER 37 CFR §1.97 and
§1.98

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants are hereby submitting references for the Examiner's consideration. However, they are mindful of the large number of references that have been cited in the IDS and attendant PTO/SB/08A and PTO/SB/08B forms filed herewith. These references have arisen during multiple litigations and oppositions involving patents that relate to the present application as well as the normal course of prosecution. Applicants have cited them to fulfill their duty of disclosure. In an effort to make the review of these references more manageable on the Examiner, Applicants have provided the PTO with multiple copies of two compact discs (CDs) with the references available for electronically viewing or searching. Previous versions of this IDS and CD set have been submitted to the PTO for references that were available at the time that the CDs were created. The current IDS incorporates additional references that have recently been disclosed in more recent litigation and a new version of the CDs (Version 3) has been prepared and sent to the PTO as discussed below. Since preparation of the latest CDs references AV-AW, CG, CQ, FI, FV, GU, HN, HP-HQ, HW, IB, IH-IQ, IS, JI, JN, KA, KM, MK-ML, MT,

NS, OL, QL, SB, XU, and YP (bolded on SB/08A/08B form) have been identified and hard copies of same are enclosed herewith.

Applicants representative, Mr. Philip McGarrigle, has provided the revised CDs to Supervisory Primary Examiners Michael Woodward and Gary Jones, and Special Examiner Cecilia Tsang. Previous versions were also given to these supervisors and Group Director John Doll. The CDs given to Mssrs. Woodward and Jones were for distribution to individual Examiners within their respective groups as they saw fit. The CDs presented to Examiner Tsang were to accompany the hard copies of the references in the IDS, which are in a central location in her office for the availability of all Examiners.

Of the two CDs that make up the IDS, one contains the articles and another contains patents/published applications. The CD containing the articles is in .pdf format and can be viewed by selecting the appropriate article as discussed below. The patent CD contains text versions and versions of the patents with the appropriate figures. It is fully searchable and contains a program that has the ability to search for specific terms or to use Boolean logic to formulate more specific searches. There are links within each full text patent to the patents that are cited therein.

The vendor who prepared the patent literature CD suggests that you open the README.HTML file in the root directory of the CD before use. It contains the directions on how to use the CD, as well as a hyperlink to the patent list. The CD that contains the articles suggests that you open "Index" or "Index2" to view images. You will see 1449 forms which list the articles which can be opened by clicking on the hyperlinked number of the article in the left hand column.

Additionally, Applicants would like to notify the Examiner of inter party matters that relate to the present application. Two commonly owned patents US 5,744,305 and US 5,800,992 have been involved in interference proceedings. Specifically, the interferences were Interference No. 104,359 between commonly owned US 5,744,305 and Brown et al., USSN

08/688,488, and Interference No. 104,358 between commonly owned US 5,800,992 and USSN 08/514,875. Both interferences have been decided (subject to current appeal in District Court of Northern California, Civil Case No. C99 21111-JF/EAI) by the USPTO in favor of real party in interest Affymetrix, the assignee of the present application. The Junior party challenged the patents on the basis of lack of enablement and written description under 35 USC §112, among other issues. The Junior party's initial position is set out in papers (with supporting information) entitled "Request for Declaration of Interference, 37 C.F.R. §1.608" in both interferences. The initial response of Senior party Patentee is set out in papers (with supporting information) entitled "Fodor's Opposition to Brown's Rule 608(b) Request" in both interferences.

Further, US 5,744,305, US 5,445,934 and US 5,800,992 have been the subject of litigation (Affymetrix, Inc. v. Hyseq, Inc., US District Court for the Northern District of California, San Francisco Division, Civil Action No. C98-03192 FMS, and Affymetrix. v. Synteni, Inc. and Incyte Pharmaceuticals, Inc., US District Court for the Northern District of California, San Francisco, Case No. C98-4508 FMS (MEJ)). In the course of these proceedings, allegations of invalidity over prior art, lack of enablement, lack of support and inequitable conduct (relating to duty of candor, content of declarations under 37 CR §1.132, and arguments made during prosecution) were raised. These allegations were denied. In a more recent lawsuit with Incyte Genomics (Incyte Genomics Inc. v. Affymetrix, U.S. District Court, Northern district of California, San Francisco division and is Case No. C 00-3210 JF.), Affymetrix counterclaimed for patent infringement under U.S. patent 5,871,928 ('928) and 6,040,193. Incyte has filed their "Initial Disclosure of Prior Art" and the references cited therein have been included into the current IDS.

All of the above lawsuits have been settled. Prior to settlement, there was a Markman decision regarding the '305 and '934 patents but no decision on the merits. In the '992 patent, the court held that the claim term "substantially complementary" was indefinite and there


was lack of written description for the word "mixture" in the claims of the '992 patent. No
~~substantive decisions were made in the lawsuit involving the '928 and '193 patents.~~

Further, oppositions have been filed against a related European application EP 619,321 in the European Patent Office, and a revocation proceeding was brought in the United Kingdom against related patents GB 2,248,840 and EP (UK) 0619 321. Collectively, these proceedings generated a considerable number of references, which were cited on the information disclosure statement and CDs filed above. Applicants can provide copies of litigation documents that may be of interest to the Examiner, but have not done so due to the extensive nature of the multiple litigation and papers filed therein. The revocation proceedings have been settled without any decision on the merits.

Applicants also wish to identify an interference that was declared and settled between an application that is related to the present application. The application serial number is 09/063,933 and the interference is declared with U.S. Patent No. 6,054,270 (E. Southern). The interference no. was 104,658. The interference has been settled with priority for certain claims to Southern. However, other claims not corresponding to the interference count have been allowed to applicants from the '933 application.

The references cited on attached form PTO/SB/08A and PTO/SB/08B are being called to the attention of the Examiner. In accordance with 37 CFR §1.98(d), copies of the references can be found in Application No. 08/348,471, filed November 30, 1994 and issued as US Patent 6,420,169 on July 16, 2002 (Attorney Docket No. 018547-000116US). It is respectfully requested that the cited references be expressly considered during the prosecution of this application, and the references be made of record therein and appear among the "references cited" on any patent to issue therefrom.

As provided for by 37 CFR 1.97(g) and (h), no representation is being made that a search has been conducted or that this statement encompasses all the possible relevant information, and no inference should be made that the information and references cited are, or



are considered to be material to patentability because they are in this statement. No inference
should be made that the information and references cited are prior art merely because they are in

this statement.

Applicant believes that no fee is required for submission of this statement.

However, if a fee is required, the Commissioner is authorized to deduct such fee from the undersigned's Deposit Account No. 20-1430. Please deduct any additional fees from, or credit any overpayment to, the above-noted Deposit Account.

Respectfully submitted,



William Schmonsees
Reg. No. 31,796

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